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APPLICATION N	NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/650,216 08/28/2003		08/28/2003	William F. Nordlin	913/38560A	7134
279	7590	04/14/2004		EXAMINER	
	•	NELL, GIANGIOR	PETERSON, KENNETH E		
BLACKSTONE & MARR, LTD. 105 WEST ADAMS STREET				ART UNIT	PAPER NUMBER
SUITE 3600				3724	
CHICAGO, IL 60603				DATE MAILED: 04/14/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	10/650,216	NORDLIN					
Office Action Summary	Examiner	Art Unit					
	Kenneth E Peterson	3724					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).							
Status							
1) Responsive to communication(s) filed on							
2a) This action is <b>FINAL</b> . 2b) This	☐ This action is <b>FINAL</b> . 2b)☐ This action is non-final.						
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is							
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4) Claim(s) 12,13,23,24 and 27-39 is/are pending 4a) Of the above claim(s) is/are withdraw 5) Claim(s) is/are allowed. 6) Claim(s) is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) 12,13,23,24 and 27-39 are subject to	n from consideration.	ment.					
Application Papers							
9) The specification is objected to by the Examiner							
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority under 35 U.S.C. § 119		•					
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>							
Attachment(s)							
1) Notice of References Cited (PTO-892)	4) Interview Summary (PTO-413) Paper No(s)/Mail Date						
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	5) Notice of Informal Pa 6) Other:						

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Restriction to one of the following inventions is required under 35 U.S.C.
 121:

- I. Claims 12,13,27-32,34-39, drawn to a tool having a pawl system engaging the second jaw to advance the jaws when the handles are moved either way, classified in class 81, subclass 300.
- II. Claims 23,24, drawn to a tool having an automatic returning mechanism, classified in class 30, subclass 261.
- III. Claim 33, drawn to a tool having both a pawl system engaging the second jaw to advance the jaws when the handles are moved either way and also an automatic returning mechanism, classified in class 30, subclass 261 and class 81, subclass 300.
- 2. The inventions are distinct, each from the other because the inventions of group I and group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the tool of group I could be employed without the automatic returning mechanism of group II, and conversely, the tool of group II could be employed with an advancing mechanism different from the one claimed by group I. See MPEP § 806.05(d).

Inventions of group III and groups I and II are related as combination and subcombination. Inventions in this relationship are distinct if there is evidence that the combination does not rely on the subcombination for patentability. See MPEP 806.05 (c), example 3. Group II is evidence that the combination of group

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III does not rely on the pawl engaging the second jaw to advance the jaws when the handles are moved either way of group I for patentability, and conversely, Group I is evidence that the combination of group III does not rely on the automatic returning mechanism of group II for patentability.

- 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
- 4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A - 2-to-1 tooth advancement ratio

Species A – 3-to-1 tooth advancement ratio

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, most of the claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- 5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp April 12, 2004

> KENNETH E. PETERSON PRIMARY EXAMINER